

## REMARKS

Claims 1-5, 7-13, and 15-36 are pending in the application. Claims 1, 4, 9, 12, 17, 20, 25, 28, 31, and 34 are independent. Claims 1-5, 7-13, 15-25, and 28 have been amended, claims 6 and 14 have been canceled, and claims 31-36 have been added. These changes are believed to introduce no new matter and their entry is respectfully requested.

### Rejection of Claims 8-10, 16-18, 22, 25-26, and 28-29 Under 35 U.S.C. §112, Second Paragraph

In paragraph 1 the Office Action, the Examiner rejected claims 8-10, 16-18, 22, 25-26, and 28-29 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention. Specifically, the Examiner states that the term “approximately fifty percent” it is not clear. Applicants respectfully traverse the rejection.

MPEP §2173.05(b) provides that “the fact claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. §112, second paragraph.... Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.” Applicants respectfully submit that, in light of the specification, a person of ordinary skill in the art would understand what the term “approximately fifty percent” means. For example, paragraph [0006] of the Specification describes “The SHPC Specification requires that when the PLED or ALED blinks, it blinks at a fifty percent duty cycle ( $\pm 5\%$ ), such as 250 nanoseconds (ns) on and 250 ns off, at a prescribed frequency.” Applicants respectfully submit that in light of this portion of the Specification a person of ordinary skill in the art would understand what the term “approximately fifty percent” means and accordingly respectfully request that the Examiner reconsider and remove the rejections to claims 8-10, 16-18, 22, 25-26, and 28-29.

### Rejection of Claims 17-24 Under 35 U.S.C. §101

In paragraph 2 of the Office Action, the Examiner rejected claims 13-18 under 35 U.S.C. §101 as being directed to non-statutory subject matter. In particular, the Examiner states that claims 13-18 are not limited to tangible embodiments because, in view of the Specification at page 12, lines 4-6, the medium is not limited to tangible embodiments, instead being defined as including intangible embodiments (e.g., computer data signal embodied in a carrier wave). By

the foregoing Amendment, Applicants have amended claims 17-24 to accommodate the Examiner. Accordingly, applicants respectfully request that the Examiner reconsider and remove the rejections to claims 17-24.

Rejection of Claims 1-2, 4, 6-7, 12, 14-15, 20, and 23-24 Under 35 U.S.C. § 102(e)

In paragraph 5 of the Office Action, the Examiner rejected claims 1-2, 4, 6-7, 12, 14-15, 20, and 23-24 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application No. 10/449,276 to Yakovlev et al (hereinafter “Yakovlev”). A claim is anticipated only if each and every element of the claim is found in a reference. (MPEP §2131 *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). The identical invention must be shown in as complete detail as is contained in the claim. *Id. citing Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)). Applicants respectfully traverse the rejection.

In paragraph 6 of the Office Action, the Examiner states that Yakovlev discloses an apparatus comprising a standard hot-plug controller for receiving at least one command from a microprocessor, the standard hot-plug controller to cause execution of a blinking pattern on at least one light emitting diode associated with at least one target peripheral card interconnect slot on a peripheral card interconnect bus, the blinking pattern to indicate the command being processed. Applicants respectfully disagree with the Examiner’s characterization of Yakovlev.

*Independent Claim 1*

Claim 1 recites in pertinent part “a hot-plug controller, the hot-plug controller having a blinking pattern controller to receive at least one command, the blinking pattern controller to: cause execution of a blinking pattern on at least one indicator associated with at least one target peripheral component interconnect slot on a peripheral component interconnect bus, ***the blinking pattern being unique to the command being processed, wherein a first unique blinking pattern is to indicate a command to turn the indicator “on” solid***”(emphasis added). Support for these changes can be found in Applicants’ Specification at paragraph [0032].

Applicants respectfully submit that Yakovlev fails to teach at least these elements. To the contrary, Yakovlev appears to only teach pressing attention button 223, which makes the power indicator 207 blink. There is no teaching or suggestion in Yakovlev of a command to turn an

indicator on solid or a unique blinking pattern to indicate a command to turn the indicator on solid. Applicants respectfully submit therefore that Yakovlev fails to teach the identical invention as claim 1 and thus does not anticipate claim 1. Accordingly, applicants respectfully request that the Examiner reconsider and remove the rejections to claim 1. Claim 2 properly depends from claim 1, which Applicants respectfully submit is patentable. Accordingly, Applicant respectfully submits that claim 2 is patentable for at least the same reasons that claim 1 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 2.

#### *Independent Claim 4*

Independent claim 4 recites in pertinent part “the hot-plug controller having a blinking pattern controller to receive at least one command, the blinking pattern controller to: cause execution of ***a first unique blinking pattern and a second unique blinking pattern*** on at least one indicator associated with at least one target peripheral component interconnect slot on a peripheral component interconnect bus, and the first unique blinking pattern ***to indicate a hard error*** occurring during processing of the command and the second unique blinking pattern ***to indicate a soft error*** occurring during processing of the command” (emphasis added). Support for these changes can be found in Applicants’ Specification at paragraph [0032].

Applicants respectfully submit that Yakovlev fails to teach at least these elements. There is no teaching or suggestion in Yakovlev of unique blinking patterns for specific errors: one blinking pattern for a soft error and a different blinking pattern for a hard error. Applicants respectfully submit therefore that Yakovlev fails to teach the identical invention as claim 4 and thus does not anticipate claim 4. Accordingly, applicants respectfully request that the Examiner reconsider and remove the rejections to claim 4. Claims 6-7 properly depend from claim 4. Accordingly, Applicant respectfully submits that claims 6-7 are patentable for at least the same reasons that claim 4 is patentable.(MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 6-7.

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### *Independent Claim 12*

Independent claim 12 recites in pertinent part “causing execution of a first unique blinking pattern and a second unique blinking pattern on at least one indicator associated with at least one target peripheral card interconnect slot on a peripheral component interconnect bus, the *first unique blinking pattern indicating a hard error* occurring during processing of the command and the *second unique blinking pattern to indicate a soft error* occurring during processing of the command (emphasis added). Support for these changes can be found in Applicants’ Specification at paragraph [0032].

Applicants respectfully submit that Yakovlev fails to teach at least these elements. Applicants respectfully submit that there is no teaching or suggestion in Yakovlev of unique blinking patterns for specific errors. There is not teaching of one blinking pattern for a hard error and a different blinking pattern for a soft error. Applicants respectfully submit therefore that Yakovlev fails to teach the identical invention as claim 12 and thus does not anticipate claim 12. Accordingly, applicants respectfully request that the Examiner reconsider and remove the rejections to claim 12. Claims 14-15 properly depend from claim 12. Accordingly, Applicant respectfully submits that claims 14-15 are patentable for at least the same reasons that claim 12 is patentable.(MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 14-15.

### *Independent Claim 20*

Independent claim 20 recites in pertinent part “causing execution of unique blinking patterns on at least one indicator associated with at least one target peripheral card interconnect slot on a peripheral component interconnect bus, and the unique blinking patterns indicating unique errors occurring during processing of the command” (emphasis added). Support for these changes can be found in Applicants’ Specification at paragraph [0032].

Applicants respectfully submit that Yakovlev fails to teach at least these elements. Applicants respectfully submit that there is no teaching or suggestion in Yakovlev of unique blinking patterns associated with their unique errors. Applicants respectfully submit therefore

that Yakovlev fails to teach the identical invention as claim 20 and thus does not anticipate claim 20. Accordingly, applicants respectfully request that the Examiner reconsider and remove the rejections to claim 20. Claims 23-24 properly depend from claim 20. Accordingly, Applicant respectfully submits that claims 23-24 are patentable for at least the same reasons that claim 12 is patentable.(MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 23-24.

#### Rejection of Claim 3 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claim 3 as obvious over Yakovlev in view of U.S Patent No. 6,463,537 to Tello et al. (hereinafter “Tello”). To establish a *prima facie* case of obviousness, an Examiner must show that that there is some suggestion or motivation to modify a reference to arrive at the claimed invention, that there is some expectation of success, and that the cited reference teaches each and every element of the claimed invention. (MPEP §2143.) Applicants respectfully traverse the rejection.

Claim 3 properly depends from claim 1, which Applicants respectfully submit is patentable. Accordingly, Applicant respectfully submits that claim 3 is patentable for at least the same reasons that claim 1 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 3.

#### Rejection of Claim 5, 13, and 21 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 5, 13, and 21 as obvious over Yakovlev. Applicants respectfully traverse the rejection.

Claim 5 properly depends from claim 4, which Applicants respectfully submit is patentable, claim 13 properly depends from claim 12, which Applicants respectfully submit is patentable, and claim 21 properly depends from claim 20, which Applicants respectfully submit is patentable. Accordingly, Applicant respectfully submits that claims 5, 13, and 21 are patentable for at least the same reasons that claims 4, 12, and 20 are patentable.(MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant

respectfully requests that the Examiner reconsider and remove the rejection to claims 5, 13, and 21.

Rejection of Claim 8-10, 16-18, 22, 25-26, and 28-29 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 8-10, 16-18, 22, 25-26, and 28-29 as obvious over Yakovlev in view of U.S Patent No. 4,423,949 to Cormier et al. (hereinafter “Cormier”). There are three possible sources for a motivation to combine references: (1) the nature of the problem to be solved, (2) the teachings of the prior art, and (3) the knowledge of persons of ordinary skill in the art. (MPEP §2143.01 citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ.2d 1453, 1457-58 (Fed. Cir. 1998).) The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (MPEP §2143.01 citng *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990).) Applicants respectfully traverse the rejection.

Applicants respectfully submit that the Examiner has failed to demonstrate a proper source of motivation or suggestion to modify Yakovlev with Cormier. Yakovlev appears to be directed to a system for diagnosing and responding to attention button signals in a peripheral interface platform. In contrast, Cormier appears to be directed to a system for detection of paper jams in photocopiers. The Examiner concedes that Yakovlev fails to teach a blinking pattern having a duty cycle less than or greater than approximately 50 percent but asserts that Cormier teaches a blinking pattern having a duty cycle less than or greater than approximately 50 percent. The Examiner then concludes that it would have been obvious to incorporate the teaching of Cormier into the system of Yakovlev because one of ordinary skill in the art would want to have this convenient operating point for the duty cycle. Applicants respectfully disagree with the Examiner.

It appears that the Examiner is relying on the “knowledge of persons of ordinary skill in the art” as a rationale for combining Yakovlev and Cormier when the Examiner concludes that “one of ordinary skill in the art would want to have this convenient operating point for the duty cycle.” This is because neither Yakovlev nor Cormier suggests the desirability of being combined with each other and neither Yakovlev nor Cormier are solving the same problem. Applicants respectfully submit, however, that the Examiner has provided no basis as to why a

person of ordinary skill in the art would have combined a system for diagnosing and responding to attention button signals in a peripheral interface platform, as disclosed in Yakovlev with a system for detection of paper jams in photocopiers, as disclosed in Cormier.

If the Examiner is relying on the statement that “one of ordinary skill in the art would want to have this convenient operating point for the duty cycle” to support the obviousness rejection, Applicants respectfully direct the Examiner to MPEP §2143.01, which points out that *a statement* that modifications to the cited reference would have been well within the ordinary skill of the art at the time the claimed invention was made *is insufficient* to support an obviousness rejection. Support must be found in the references themselves. Absent such support, the Examiner has not made out a *prima facie* case of obviousness with respect to the claims and claims 8-10, 16-18, 22, 25-26, and 28-29 are thus patentable over Yakovlev in view of Cormier. Applicants respectfully request therefore that the Examiner reconsider and remove the rejection of claims 8-10, 16-18, 22, 25-26, and 28-29.

#### Rejection of Claim 11 and 19 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 11 and as obvious over Yakovlev in view of Cormier in further view of U.S Patent No. 6,463,537 B1 to Tello (hereinafter “Tello”). Applicants respectfully traverse the rejection.

Claim 11 properly depends from claim 9, which Applicants respectfully submit is patentable, and claim 14 properly depends from claim 12, which Applicants respectfully submit is patentable. Accordingly, Applicant respectfully submits that claims 11 and 14 are patentable for at least the same reasons that claims 9 and 12 are patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 11 and 14.

#### Rejection of Claim 27 and 30 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 11 and as obvious over Yakovlev in view of Cormier in further view of U.S Patent No. 6,564,329 B1 to Cheung et al. (hereinafter “Cheung”). Applicants respectfully traverse the rejection.

Claim 27 properly depends from claim 25, which Applicants respectfully submit is patentable, and claim 30 properly depends from claim 28, which Applicants respectfully submit is patentable. Accordingly, Applicant respectfully submits that claims 27 and 30 are patentable for at least the same reasons that claims 25 and 28 are patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 27 and 30.

#### New Claims 31-34

Applicants have added new claims 31-34. New claim 31 recites in pertinent part “receiving a command at a standard hot-plug controller from a microprocessor; and causing execution of a blinking pattern on at least one indicator associated with at least one target peripheral component interconnect slot on a peripheral component interconnect bus, the blinking pattern indicating the command being processed.” New claim 34 recites in pertinent part “a hot-plug controller having a blinking pattern controller to receive at least one command, the blinking pattern controller to cause execution of a blinking pattern on at least one indicator associated with at least one target peripheral component interconnect slot on a peripheral component interconnect bus, the blinking pattern being unique to the command being processed, wherein a first unique blinking pattern is to indicate a first command to turn the indicator “on” solid.” Support for these claims can be found in Applicants’ Specification at paragraph [0032].

Applicants respectfully submit that Yakovlev, Tello, Cormier, and/or Cheung either alone or in combination fail to teach or fairly suggest the subject matter recited in independent claims 31 and/or 34. Claims 32-33 properly depend from claim 31. Claims 35-36 properly depend from claim 34. Accordingly, Applicant respectfully submits that because Yakovlev, Tello, Cormier, and/or Cheung either alone or in combination fail to teach or fairly suggest the subject matter recited in independent claims 31 and/or 34 and that claims 32-33 properly depend from claim 31 and claims 35-36 properly depend from claim 34, that claims 31-36 are patentable over Yakovlev, Tello, Cormier, and/or Cheung either alone or in combination.



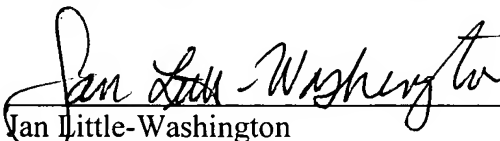
## CONCLUSION

Applicants submit that all grounds for rejection have been properly traversed, accommodated, or rendered moot, and that the application is in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

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